



00862.021956

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

KATSUHIKO NAGASAKI

Application No.: 09/619,540

Filed: July 19, 2000

For: INFORMATION
PROCESSING APPARATUS,
CONTROL METHOD
THEREFOR, AND
COMPUTER-READABLE
MEMORY

Examiner: M. Rahmjoo

Group Art Unit: 2676

May 14, 2004

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MAY 18 2004

Technology Center 2600

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR NEW OFFICE ACTION

Sir:

Applicant has received an Office Action dated April 29, 2004 (Paper No. 16) for the above-identified application which is seen to be erroneous. Specifically, the Office Action does not establish how non-elected Claims 25 to 47 are independent or distinct from the originally claimed invention, as required by MPEP 821.03 and 37 CFR § 1.145. Rather, the Office Action merely lists what Claims 25 to 47 are directed to, without establishing that the claims are independent or distinct from the originally claimed invention. This contravenes 37 CFR § 1.145, which requires such as a factual predicate before a constructive election can be imposed:

“If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144” (emphasis added).

Moreover, Applicant respectfully submits that Claims 25 to 47 are not seen to be independent or distinct from the originally claimed invention. Instead, the language of Claims 25 to 47 is seen to be similar to that of the originally claimed invention, although it is true that Claims 25 to 47 are in different statutory classes. However, a difference in statutory classes, taken alone, is not a sufficient basis to support restriction.

Applicant’s representative attempted to resolve this matter by contacting the Examiner. During the telephone conversation, the Examiner indicated that there is no requirement for establishing how the non-elected claims are independent or distinct from the originally claimed invention. However, this requirement can be found under MPEP 821.03 and 37 CFR § 1.145, as indicated above.

A new Office Action is warranted to correct this error. In addition, the current Office Action does not present enough information for how to obtain reconsideration of this matter. The only option presented by the current Office Action is the cancellation of Claims 25 to 47.

Accordingly, Applicant respectfully requests a new Office Action which clearly sets forth how the non-elected claims are independent or distinct from the originally claimed invention, and clearly sets forth how Applicant can obtain reconsideration of this matter. Furthermore, Applicant respectfully requests that a new period for reply be set commencing with the date a new Office Action is mailed.

Applicant's undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,


Attorney for Applicant

Registration No. 32622

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-2200
Facsimile: (212) 218-2200

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